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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,630	05/26/2000	Robert McKinnon JR.	5925.36003	7855
21000 7590 06/13/2008 DECKER, JONES, MCMACKIN, MCCLANE, HALL & BATES, P.C. BURNETT PLAZA 2000 801 CHERRY STREET, UNIT #46 FORT WORTH, TX 76102-6836				
EXAMINER ELOSHWAY, NIKI MARINA				
ART UNIT 3781		PAPER NUMBER		
MAIL DATE 06/13/2008		DELIVERY MODE PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT MCKINNON, JR.

Appeal 2008-2146
Application 09/579,630
Technology Center 3700

Decided: June 13, 2008

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
CHARLES F. WARREN, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's non-final rejection¹ of claims 1 through 7, 9, 12, 13, 15 through 35, 37, 39, 40, and 58 through 75. Claims 42 and 44, the other claims

¹ Appellant properly appeals from the Examiner's non-final rejection since the claims on appeal have been twice rejected. 35 U.S.C. § 134(a) (stating “[a]n applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences.”).

pending in the above-identified application, were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. We have jurisdiction pursuant to 35 U.S.C. § 6.

STATEMENT OF THE CASE

The subject matter on appeal is directed to a removable solid plastic lid for covering a utility box, such as a water meter box, that is capable of withstanding at least an 8,000 pound load. Spec. 4. Appellant states that his invention involves (1) compression molding plastic material, such as medium density polyethylene, to form a solid plastic lid and (2) reducing the amount of plastic material used in the solid plastic lid capable of withstanding at least an 8,000 pound load via the formation of recesses. (Spec. 2 and 3). According to Appellant, forming a solid plastic lid having a height of 1.5 inches by compression molding alone results in cracking because the lid is unable to fully cure. *Id.* In order to manufacture a plastic lid that can withstand an 8,000 pound load, Appellant states that recesses, which range from 0.0875 to 1 inch, must be formed in such compression molded lid. *Id.* Further details of the appealed subject matter are recited in representative claim 5 reproduced below:

5. A lid for a utility box, comprising:

a compression molded solid member made only of plastic material and having spaced apart upper and lower sides and an outer edge,

said outer edge extends around said member next to said lower side and which faces outward of said member,

said lower side comprising a lower surface which is contiguous with said outer edge at least on two opposite sides of said outer edge,

a plurality of spaced apart recesses having outer edges at said lower surface which are spaced from said outer edge of said member such that said lower surface surrounds said outer edges of said recesses,

said recesses being formed during the molding process to enhance curing of the plastic material and hence the quality of the lid,

each of said recesses comprises a surface which extends from its said outer edges into the said member,

said outer edges of each of said recesses comprise two spaced apart elongated outer edges and two spaced apart shorter outer edges,

said elongated edges of said recesses are generally parallel with each other,

said member has a given dimension along which said elongated edges of said recesses extend,

the lengths of said elongated edges of said recesses are greater than one half of said given dimension of said member,

said member of said lid has the strength sufficient to withstand a load of at least 8,000 pounds applied to said upper side when said lower side is supported by means placed around a perimeter of said member.

The Examiner has relied upon the following references:

Hauffe	3,921,449	Nov. 25, 1975
Goodwin	5,564,586	Oct. 15, 1996
Bonnema	4,726,490	Feb. 23, 1988
Marthaler	5,755,350	May 26, 1998

The Examiner has rejected the claims on appeal as follows:

- 1) Claims 5, 6, 13, 18, 19, 25, 39, 40, 59, 60, 62, 69, 72, 74 and 75 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hauffe;
- 2) Claims 1, 3, 4, 9, 12, 15-17, 37 and 58 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hauffe and Goodwin;
- 3) Claim 2 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hauffe, Goodwin, and Bonnema;
- 4) Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the combined disclosures of Hauffe and Bonnema;
- 5) Claims 20-24, 26-35, 61, and 63-65 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Hauffe;
- 6) Claims 66-68, 70, 71, and 73 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Hauffe;
- 7) Claims 5, 6, 13, 18-35, 39, 40, and 59-75 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hauffe and Marthaler;
- 8) Claims 1, 3, 4, 9, 12, 15-17, 37, and 58 under 35 U.S.C. § 103(a) as unpatentable over Hauffe in view of Goodwin and Marthaler;
- 9) Claim 2 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hauffe, Goodwin, Marthaler, and Bonnema; and

10) Claim 7 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hauffe, Marthaler, and Bonnema.

ISSUES

1. Has the Examiner demonstrated that Hauffe teaches either expressly or inherently each and every limitation recited in claims 5, 18, 25, 59, 60, 62, 69, and 72 within the meaning of 35 U.S.C. § 102(b)?
2. Has the Examiner identified a reason that would have prompted one of ordinary skill in the art to employ a lid capable of withstanding 8,000 pounds as required by claims 1, 5, 18, 23, 25, 26, 31, 58, 59, 60, 61, 62, 63, 65, 66, 69, 71, and 72 within the meaning of 35 U.S.C. § 103(a)?

PRINCIPLES OF LAW, FACTUAL FINDINGS, AND ANALYSES

ANTICIPATION

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, (Fed. Cir. 1987). “Inherency, however, may not be established by probabilities or possibilities. *In re Oelrich*, 666 F.2d 578, 581-82, (CCPA 1981). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990)(citations omitted).

In applying the above principles of law to the present facts, we determine that the Examiner has not established a prima facie case of anticipation. The Examiner recognizes that Hauffe is silent regarding the limitation "said lid has the strength sufficient to withstand a load of at least 8,000 pounds" as required by claims 5, 18, 25, 59, 60, 62, 69, and 72. (Ans. 7). The Examiner also recognizes that this claim limitation is a function of the lid's dimension (e.g., thickness). *Id.* The Examiner, however, has not provided any basis to support the determination that Hauffe's lid is capable of withstanding a load of 8,000 pounds. *Id.* Specifically, the Examiner has not directed us to any lid dimensions in Hauffe that are capable of supporting a load of 8,000 pounds.

On this record, the Examiner has simply not supplied any reasoning to support the determination that Hauffe's lid can withstand a load of at least 8,000 pounds.

Accordingly, for the reasons stated by the Appellant in the Brief and above, we reverse the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 102(b).

OBVIOUSNESS

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). "[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out

precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* at 1741-42, *quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

As discussed above, Hauffe does not expressly or inherently teach the limitation "said lid has the strength sufficient to withstand a load of at least 8,000 pounds" in claims 1, 5, 18, 23, 25, 26, 31, 58, 59, 60, 61, 62, 63, 65, 66, 69, 71, and 72. Furthermore, on this record, the Examiner has not provided any articulated reasoning why the making and employment of such a feature would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

Accordingly, we are constrained to reverse the Examiner's decision rejecting the claims on appeal under 35 U.S.C. § 103(a) as well.

ORDER

On this record, the decision of the Examiner is reversed.

REVERSED

tf/lis

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